

REMARKS

Claims 1-49 are pending in this application. By this Amendment, claims 1-5, 14 and 18 are amended. The amendments introduce no new matter. Reconsideration of the application based on the above amendments and following remarks is respectfully requested.

I. The Claims Are Allowable Over Arcuri

The Office Action, on page 2, rejects claims 1, 4, 6, 8, 10-15, 17-19, 27, 35, 39, 43 and 48 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,121,968 to Arcuri et al. (hereinafter "Arcuri"). This rejection is respectfully traversed.

A brief review of the prosecution history of this application indicates that in an Office Action mailed on July 28, 2004, independent claims 1 and 4, among other claims, were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,880,727 to Barrett et al. (hereinafter "Barrett"). The rest of the pending claims, including independent claims 2 and 5, were rejected under 35 U.S.C. §103(a) as being unpatentable over Barrett in view of Kino (discussed below) and Hocker (discussed below). Based on claim amendments and arguments provided in an Amendment filed on October 25, 2004, supported by a personal interview conducted with Examiners Vu and Kincaid on October 29, 2004, it was agreed that the Amendment appeared to overcome the prior art rejections of the Office Action. In a Final Rejection mailed on March 9, 2005, independent claims 1 and 4, among other claims, were rejected under 35 U.S.C. §103(a) as being unpatentable over Barrett and Arcuri. The rest of the pending claims were rejected under 35 U.S.C. §103(a) as being unpatentable over Barrett and Arcuri in combination with Hocker and Kino. Applicant's representative requested a personal interview to discuss the newly asserted prior art rejections of the Office Action. Ultimately, Examiner Vu refused to grant Applicant's representative a personal interview. In an Amendment After Final Rejection (AAFR) filed on June 9, 2005, Applicant traversed the prior art rejections of the Office Action arguing, among other issues, that the combination of

Barrett and Arcuri did not render the subject matter of the pending claims obvious, and further that Barrett and Arcuri were not combinable in the manner suggested by the Office Action. An Advisory Action was mailed on July 11, 2005 that indicated that the June 9 AAFR was not considered to place the application in condition for allowance, was considered to raise new issues regarding further examination and/or search, and, as such, was not entered. In the Remarks that accompanied the Advisory Action, the Examiner indicated that Arcuri was believed to teach a user interface with a list of user-selectable items that could be dynamically re-arranged/changed. On August 5, 2005, Applicant filed an Amendment, Request for Continued Examination, and Petition for Extension of Time in the U.S. Patent and Trademark Office. The Amendment strengthened Applicant's arguments regarding what Arcuri could not be reasonably considered to teach, or to have suggested, and responded specifically to comments in the July 11 Advisory Action. Based on the foregoing, Applicant believes that it is unreasonable at this point in prosecution to assert that Arcuri alone is now regarded as teaching all of the combinations of features varying recited in claims 1, 4, 6, 8, 10-15, 17-19, 27, 35, 39, 43 and 48.

Arcuri teaches drop-down menus provided by a computer program in two states -- a short menu state and a long menu state -- indicating that when a user opens a desired menu, the menu opened will initially take the form of a short menu of executable commands which are a subset of the total number of executable commands available under the selected menu (Abstract).

The Office Action alleges that Arcuri teaches a display device in an image forming apparatus comprising a display unit. The monitor 47 shown in Fig. 1 of Arcuri is asserted to correspond to the display unit in the display device in the image forming apparatus. Further, the Office Action indicates that Arcuri teaches "a display arrangement control device," although no specific reference is provided regarding where such a device is disclosed in the

reference. The Office Action relies on the depictions in Figs. 2A-2D of Arcuri, and the description at col. 2, lines 10-22 as teaching the features recited in the pending claims.

The cited portion of Arcuri discloses a system and method for dynamically changing the available commands in a given short menu based upon the particular needs and utilization behavior of a user. Arcuri discloses that in general drop down menus provided by a computer program are provided in two states, a short menu state and a long menu state, such that when the user opens a desired menu that menu will initially take the form of a short menu containing a subset of executable commands of the total number of executable commands available under the selected menu. The short menu may be dynamically expanded into a long menu which will contain the complete set of executable commands available under the selected menu. There is nothing in this complete description of what Arcuri is alleged to teach that can reasonably be considered to teach, or even to have suggested, a display device comprising (1) a display unit, as discussed above, and (2) a display arrangement control device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement.

In reviewing the anticipation standard, the Federal Circuit has stated "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 1436 (2002) (emphasis added). Additionally, other court precedent clarifies the requirements for anticipation, stating that "the reference ... must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524 (CCPA 1972); *see also Sandisk Corp. v. Lexar Media, Inc.*, 91

F. Supp. 2d 1327, 1336 (N.D. Calif. 2000) (stating that "[u]nless all the elements are found in a single piece of prior art in exactly the same situation and united the same way to perform the identical function, there is no anticipation.") and *Aero Industries Inc. v. John Donovan Enterprises-Florida Inc.*, 53 USPQ2d 1547, 1555 (S.D. Ind. 1999) (stating that "[n]ot only must a prior patent or publication contain all of the claimed elements of the patent claim being challenged, but they 'must be arranged as in the patented device' ").

This standard for anticipation is also set forth in MPEP §2131, which states that "the identical invention must be shown in as much detail as is contained in the . . . claim."

Further, although the same terminology need not be used, "the elements must be arranged as required by the claim." This standard is simply not met here.

Independent claim 1 recites, and independent claims 4, 14 and 18 varyingly recite, among other features, a display device in an image forming apparatus (or a display method for displaying user-selectable image forming function options on a display unit in an image forming apparatus) comprising a display unit that displays a plurality of user-selectable image forming function options which can be performed by at least one of the image forming apparatus or an additional device mounted to the image forming apparatus; and display arrangement control device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement, wherein a plurality of the available user-selectable image forming function options are displayed in a first case, less than all of the plurality of the user-selectable image forming function options that are displayed in the first case are displayed in a second case, and all user-selectable image forming function options displayed in the second case are displayed in the first case, the display arrangement control device modifying the display on the display unit from the first case to the second case.

In Arcuri, whether the short menu or the long menu is displayed, individual executable commands are not arranged in a potentially changing arrangement as may be determined by a display arrangement control device, which, as indicated above is not shown to be disclosed anywhere in Arcuri. As such, Arcuri cannot reasonably be read to anticipate such a feature, and as such, the subject matter of the pending claims.

For any of the above reasons, Arcuri cannot reasonably be considered to teach, or to have suggested, the subject matter recited in at least independent claims 1, 4, 14 and 18. Further, claims 6, 8, 10-13, 15, 17, 19, 27, 35, 39, 43 and 48 also are neither taught, nor would they have been not have been suggested, by Arcuri at least for their respective dependence directly or indirectly on the enumerated independent claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 4, 6, 8, 10-15, 17-19, 27, 35, 39, 43 and 48 under 35 U.S.C. §102(e) as being anticipated by Arcuri are respectfully requested.

II. Combining Arcuri With Other References Does Not Overcome The Above Shortfall In The Application Of That Reference To The Claimed Subject Matter

A. The Office Action, on page 5, rejects claims 2, 5, 25, 28, 29, 33, 36, 37, 40, 41, 45, 46 and 49 under 35 U.S.C. §103(a) as being unpatentable over Arcuri and U.S. Patent No. 6,469,719 to Kino et al. (hereinafter "Kino"). This rejection is respectfully traversed.

Kino generally discloses a layout unit referring to a plurality of menu items that are substantially composed of character strings displayed in a predetermined area of a screen in a graphical user interface of a digital communication apparatus or household appliance (Abstract; col. 1, lines 17-22; and col. 3, lines 36-53) (emphasis added).

Kino neither discloses, nor would it have suggested, a display unit that displays a plurality of user-selectable image forming function options and a display arrangement control

device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement, as is recited, among other features, in independent claims 2 and 5. The arguments applicable to the application of Arcuri to claims 1 and 4 above are equally applicable regarding the application of Arcuri to independent claims 2 and 5. Kino does not overcome the shortfall in the application of Arcuri to any of the independent claims, specifically claims 2 and 5.

For at least these reasons, the combinations of all of the features recited in independent claims 2 and 5 are, therefore, not rendered obvious by the combination of the applied references. Further, claims 25, 28, 29, 33, 36, 37, 40, 41, 45, 46 and 49, would also not have been rendered obvious by the combination of Arcuri and Kino, for at least the respective dependence of these claims directly or indirectly on allowable independent claims, as well as for the separately patentable subject matter that each of these claims recites.

As such, the combination of the applied references cannot reasonably be read to have rendered obvious the combinations of all of the features recited in claims 2, 5, 25, 28, 29, 33, 36, 37, 40, 41, 45, 46 and 49. Accordingly, reconsideration and withdrawal of the rejection of claims 2, 5, 25, 28, 29, 33, 36, 37, 40, 41, 45, 46 and 49 under 35 U.S.C. §103(a) as being unpatentable over Arcuri and Kino are respectfully requested.

B. The Office Action, on page 8, rejects claims 3, 26, 34, 38, 42 and 47 under 35 U.S.C. §103(a) as being unpatentable over Arcuri and U.S. Patent No. 5,754,179 to Hocker et al. (hereinafter "Hocker"). This rejection is respectfully traversed.

In like manner to the discussion of independent claims 1, 2, 4 and 5, for at least the arguments made above, Arcuri neither discloses, nor would it have suggested, all of the features recited in independent claim 3. Further, Hocker teaches a capability to allow a user to rapidly determine interrelatedness of icons on a graphical user interface (Abstract)

(emphasis added). Specifically, Hocker teaches substantially that when an icon is selected, other related icons are then distinguished by one of a plurality of distinguishing features, such as by brightening, by rounded corners, or by an oval shape and/or highlighted text (col. 1, line 67 - col. 2, line 4).

A preset arrangement of icons wherein, based on a selection of one certain icon, other icons are highlighted and/or have their shape provisionally modified based on the selection of that first icon, to any extent that such a capability may even be reasonably viewed as combinable with the teachings of Arcuri, a conclusion that Applicant does not concede, does not overcome the shortfall in the application of Arcuri to the features recited in independent claim 3. Specifically, the combination of the applied references neither teaches, nor would it have suggested, the recited display unit or a display arrangement control device that determines an arrangement of the plurality of user-selectable image forming function options, and arranges the plurality of user-selectable image forming function options in the determined arrangement, wherein a plurality of the available user-selectable image forming function options are displayed in a first case, less than all of the plurality of the user-selectable image forming function options that are displayed in the first case are displayed in a second case, and all user-selectable image forming function options displayed in the second case are displayed in the first case, the display arrangement control device modifying the display on the display unit from the first case to the second case so that at least one of the user-selectable image forming function options displayed in both cases is displayed in a shape which is different in the first case than in the second case, as recited, among other features, in claim 3.

Further, claims 26, 34, 38, 42 and 47 would not have been rendered obvious by the combination of Arcuri and Hocker for at least the respective dependence of these claims directly or indirectly on allowable independent claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 3, 26, 34, 38, 42 and 47 under 35 U.S.C. §103(a) as being unpatentable over Arcuri and Hocker are respectfully requested.

C. The Office Action, on pages 9-13, varyingly rejects claims 7, 9, 16, 20-24 and 29-32 under 35 U.S.C. §103(a) as being unpatentable over Arcuri in various combinations with Kino, Hocker and U.S. Patents Nos. 5,625,783 to Ezekiel et al. (hereinafter "Ezekiel") and 6,433,801 to Moon et al. (hereinafter "Moon"). These rejections are respectfully traversed.

The arguments set forth above traversing the prior art rejections of independent claims 1-5, 14 and 18 are not overcome by the application of the varyingly applied additional references in any combination of Kino, Hocker, Ezekiel and/or Moon to the subject matter of the enumerated dependent claims. Dependent claims 7, 9, 16, 20-24 and 29-32 depending from the various independent claims would, therefore, not have been suggested by any combination of the applied references at least for the respective dependence of these claims directly or indirectly on allowable independent claims, as well as for the separately patentable subject matter that each of these claims recites.

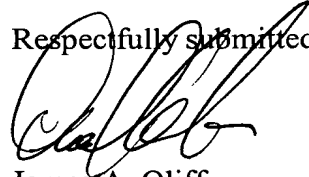
Accordingly, reconsideration and withdrawal of the rejections of claims 7, 9, 16, 20-24 and 29-32 under 35 U.S.C. §103(a) as being unpatentable over any combination of the applied references are respectfully requested.

III. Conclusion

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-49 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



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